SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-429

IDAS B. WHITE, *Petitioner*

v.

HARRINGTON MANUFACTURING CO., INC., *Respondent*

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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INTRODUCTION

Although creativity is ordinarily considered to be the exclusive province of inventors, Petitioner's attorneys have exhibited an extraordinary degree of creativity by synthesizing an issue for this Court which has no basis in the record and no basis in fact,

The Fifth Circuit Court of Appeals held that the explicit wording of claim 10 of the patent in suit specifically delineated the very thing which Petitioner manufactured and sold, so that there was no question that

Petitioner was guilty of infringement. Petitioner ignores this clear-cut case of infringement of claim 10 and presents the diversionary argument that, because other claims in the patent contain language that is not as detailed as claim 10, such other claims do not satisfy 35 USC 112. Since the issue of infringement in this lawsuit can be fully and fairly disposed of by claim 10, there is no need for this Court to decide how many of the other less detailed patent claims are also infringed by Petitioner.

BRIEF COMMENT ON PETITIONER'S STATEMENT OF FACTS

Petitioner's statement of facts has been abbreviated and phrased in such a way as (a) to make the inventive efforts of the patentees seem minimal and (b) to make it appear that Petitioner was not guilty of copying the combination of elements which makes up the patented Meece-Dew tree shear. Rather than attempt to correct and refute all of the erroneous inferences that are inherent in Petitioner's Statement of the Case, Respondent will simply say that there is no doubt that Meece and Dew were the first inventors of the tree shear that is disclosed and claimed in their patent, that their tree shears were widely advertised, distributed, and sold by their licensee in the locale of Petitioner's manufacturing facility before Petitioner ever started building his first shear, that a commercial Meece-Dew shear was inspected by a close friend of Petitioner well before Petitioner even completed his first experimental tree shear, and that Petitioner's infringing tree shear is so nearly identical to that of the patentees that the derivation of Petitioner's tree shear design is obvious. The Meece-Dew tree shear was instrumental in solving long-standing prob-

lems in the forest, and has experienced great commercial success in the seven years since it was introduced to the logging industry.

A SUMMARY OF PETITIONER'S ARGUMENTS

Petitioner has devised the following line of reasoning:

1. claims 1 and 2 of the patent in suit define one of the elements of the novel patented combination as a "flexible interconnection means";
2. the phrase "flexible interconnection means" is a "means plus function" clause;
3. prior to 1952 this Court rendered several decisions wherein it invalidated claims containing certain improper types of "means plus function" clauses;
4. in 1952 Congress enacted into law 35 USC 112, the third paragraph of which approves defining an element in a claim for a combination as a means for performing a specified function;
5. a majority of the patents which now issue contain claims having means plus function clauses;
6. the Court below allegedly erred in upholding certain patent claims in suit which defined one element thereof as a means for performing a specified function, and this alleged error affords this Court an opportunity to "speak out" relative to the propriety or impropriety of "means plus function" clauses and 35 USC 112.

This line of reasoning is incorrect and misleading in several respects, as will be set forth hereinafter.

PETITIONER FAILED TO MENTION A FACT OF CONTROLLING IMPORTANCE

In presenting the foregoing line of argument, Petitioner completely ignored a determinative fact which formed the basis of the Court of Appeals decision below, i.e. Petitioner failed to point out that the primary claim in suit was claim 10 and that claim 10 is really not a means plus function claim at all. Claim 10 specifically recites, in *structural* terms, that the "flexible interconnection means" element of the claimed combination is an "adjustable hydraulic cylinder". An adjustable hydraulic cylinder is exactly what Petitioner used in his infringing device.

It is very difficult to understand how Petitioner could have possibly thought that by ignoring claim 10 in his petition, it would somehow "go away" or that the Court would overlook it. In any event, claim 10 completely destroys the entire basis of the petition.

PETITIONER'S ARGUMENT RELATIVE TO THE APPLICABILITY OF 35 USC 112 IS A PURE "AFTER-THOUGHT" WHICH WAS NEVER EVEN MENTIONED IN EITHER OF THE TWO LOWER COURTS

In Petitioner's main brief before the Fifth Circuit Court of Appeals, and particularly in Petitioner's request for rehearing to that Court, no allegation was ever made that the patent claims violated 35 USC 112. Petitioner likewise never mentioned 35 USC 112 in any of his briefs before the District Court. Accordingly, Petitioner's argument as to the applicability of 35 USC 112 is a mere after-thought conceived solely for the purpose of this petition.

It is submitted that it would be totally inappropriate for this Court to use this case to treat a legal issue

which was neither presented to the Trial Court or Court of Appeals below, nor germane to their decisions. The decision below was entirely factual, and found infringement of a claim (claim 10) which did not even include a "means-plus function" recitation of the type contemplated by 35 USC 112.

CLAIM 10 OF THE PATENT IN SUIT IS NOT FUNCTIONAL BECAUSE IT SPECIFICALLY DELINEATES THE VERY THING WHICH PETITIONER'S SHEAR USES

The Court below was fully aware that the most relevant patent claim in this lawsuit did not require any interpretation of a "means plus function" clause. For example, the Court of Appeals opinion states: (Page 40a of Petitioner's Appendix)

> "Thus, Claim 10 *specifically delineates* as a part of the Meece-Dew invention *the very thing* which White's shear uses" (emphasis added).

Footnote 7 on this same page of the opinion states:

> "Our disposition of the *explicit wording* of Claim 10 precludes any foray into the range of protection which might be afforded to Harrington under the doctrine of equivalents" (emphasis added).

Claim 10 of the patent in suit reads: (appendix page 60a):

> "A tree cutting device according to claim 1, wherein said flexible interconnection means comprises an *adjustable hydraulic cylinder*" (emphasis added).

Since the explicit wording of Claim 10 specifically delineates the "flexible interconnection means" recited in claim 1, as being "an adjustable hydraulic cylinder", and since an adjustable hydraulic cylinder

is precisely what petitioner used in his tree shear, there is no possible way in which Claim 10 can be considered "functional".

The third paragraph of 35 USC 112 becomes relevant to a question of claim construction only when "An element in a claim for a combination [is] expressed as a means . . . for performing a specified function *without the recital of structure* . . ." That statutory provision is clearly not applicable to claim 10 of the patent in suit because Claim 10 *does* contain a "recital of structure". Petitioner's failure to even mention Claim 10 of the patent in his petition for certiorari confirms that this claim completely destroys the basis for the petition.

THE HALLIBURTON AND GENERAL ELECTRIC DECISIONS OF THE SUPREME COURT

Petitioner urges that "this case is a classic example of the danger proscribed by the rationale of the *Halliburton, General Electric* and earlier decisions". This is simply not so. The present case does not conflict in any way with those decisions. In the *Halliburton* case the Court pointed out that its conclusion was not in conflict with an earlier decision (*Continental Paper Bag Co* v. *Eastern Bag Co.* 210 U.S. 405, 28 S. Ct. 748 52 L. Ed. 1122) wherein the Court had approved a patent claim which contained a means plus function clause, because the claims in the *Continental* case structurally described the physical and operating relationship of all of the crucial parts of the novel combination. Claim 10 in suit thus falls precisely within what was approved by the *Halliburton* case, i.e. the explicit wording of Claim 10 specifically delineates all of the crucial parts of the novel combination and corresponds exactly with the infringer's tree shear.

In the *Halliburton* case the alleged infringer used a combination of elements which the patentee did not either specifically disclose or claim. In sharp contrast, the patent before this Court does specifically disclose and specifically claim the exact combination of elements which Petitioner made and sold.

The *General Electric* case cited by Petitioner is also irrelevant to the present case. In *General Electric* (304 U.S. at p. 371) it was noted that the patentee's claims used "indeterminate adjectives which describe the function of the grains *to the exclusion of any structural definition*". Claim 10 of the patent in suit defines the "flexible interconnection means" as an "adjustable hydraulic cylinder" — which is exactly the structure which Petitioner used in his infringing tree shear.

THE COURT BELOW DID NOT USE THE PATENT SPECIFICATION TO ENLARGE THE SCOPE OF THE PATENT CLAIMS

Petitioner accuses the Court below of (a) using the specification of the patent in suit to enlarge the scope of the patent claims and (b) rewriting the patent claims beyond their proper limits. Nothing could be further from the truth.

The Meece et al patent in suit describes the exact structure used in Petitioner's infringing device. Thus, the patent specification states (middle of appendix page 58):

> "* * * the basic concept is that of having a means for varying the angle of the plane of the jaw members with respect to the beam 13. Consequently, no invention would be involved in *replacing* flexible cable 22 or chain 33 with an obvious

> equivalent, such as a *hydraulic cylinder* * * *". (Emphasis added)

Claim 10 of the patent in suit is directed to this disclosure, i.e. the claim states that the flexible interconnection means (of claim 1)

> "comprises an adjustable hydraulic cylinder".

When the Court below held (Petitioner's Appendix page 40a)

> "Thus, Claim 10 *specifically delineates* as a part of the Meece-Dew invention *the very thing* which White's shear uses" (emphasis added).

and noted (footnote 7 on appendix page 40a)

> "Our disposition of the *explicit wording* of Claim 10 precludes any foray into the range of protection which might be afforded to Harrington" (emphasis added).

the Court was not enlarging the scope of, or rewriting, claim 10. Instead, the Court below was simply stating, correctly, that claim 10 read *directly* on the accused structure, and that the claim was supported *directly* by the Meece and Dew specification.

There is absolutely no basis for accusing the lower Court of enlarging the scope of a patent claim when the explicit wording of that claim specifically delineates the exact structure made and sold by Petitioner.

IF THIS COURT WISHES TO "SPEAK OUT" ON 35 USC 112, IT SHOULD DO SO WHEN IT HAS AN INSTANCE WHERE A PATENTEE IS TRYING TO USE A "MEANS PLUS FUNCTION" CLAIM TO ENCOMPASS SOMETHING WHICH IS NOT SPECIFICALLY DISCLOSED IN HIS PATENT SPECIFICATION

It is obvious that Petitioner hopes this Court will "speak out" as to the third paragraph of 35 USC 112 and "means plus function" clauses. If this Court has any desire to so "speak out" the patent involved in this lawsuit does not constitute an appropriate vehicle for such an exposition. Instead, the Court should await an instance where a patentee is trying to stretch a "means plus function" clause to encompass something which he did not specifically disclose in his patent specification.

Any discussion by this Court of the third paragraph of 35 USC 112 based on the patent of the present lawsuit would constitute *dictum* because infringed patent claim 10 in suit encompasses structure which is specifically spelled out in the patent specification. The explicit wording of claim 10 delineates the very thing which the accused shear uses. "Means plus function" considerations are totally irrelevant to Petitioner's infringement of Claim 10.

THE DECISION OF THE COURT BELOW IS NOT INCONSISTENT WITH THE PRIOR DECISIONS OF OTHER COURTS

Pages 14 and 15 of the petition refer to four decisions of the Court of Customs and Patent Appeals and four decisions of Courts of Appeal. The decision of the Court below is not inconsistent with the holdings in any of these other cases. If those other courts

had been presented with a patent wherein the explicit wording of one of the claims (such as claim 10 in suit) specifically delineated the structure of the infringer, they would undoubtedly have reached exactly the same decision as the Court below in the present case.

Petitioner's contention (Petition pp. 12 et seq) that "the time has come for this Court to furnish its guidance" regarding 35 USC 112 is markedly at variance with pages 14-15 of the petition wherein Petitioner correctly notes that the Court of Customs and Patent Appeals, and various Circuit Courts of Appeals, have had no difficulty in applying 35 USC §112, and have reached entirely consistent results. Accordingly, Petitioner's argument reduces to a contention that, whereas the appellate courts including the Fifth Circuit (page 15 of the petition) generally understand and correctly apply 35 USC 112, the Fifth Circuit did not do so in this one case. Even if this were true (which it isn't) it is not the function of this Court to correct isolated aberrations of the lower courts.

CONCLUSION

The Court below stated that, compared with the patent claims of its past experience, the claims of the patent in suit were "a model of clarity" (footnote 8 at Petitioner's Appendix page 41a). Claim 10 precisely defines the exact structure which the infringer made and sold. The precision of the claim language in this case precludes, and makes irrelevant, a review by this Court of the third paragraph of 35 USC 112.

The Petition for Certiorari should be denied.

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